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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
09/945,361	08/31/2001	James Robert Kitchen	5681-03900	2095				
7590 03/05/2004								
B. Noel Kivlin Conley, Rose, & Tayon, P.C. P.O. Box 398 Austin, TX 78767		<table border="1"> <tr> <td>EXAMINER</td> </tr> <tr> <td>PAIK, STEVE S</td> </tr> </table>			EXAMINER	PAIK, STEVE S		
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		<table border="1"> <tr> <td>ART UNIT</td> <td>PAPER NUMBER</td> </tr> <tr> <td>2876</td> <td></td> </tr> </table>			ART UNIT	PAPER NUMBER	2876	
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DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

Office Action Summary	Application No. 09/945,361	Applicant(s) KITCHEN, JAMES	
	Examiner Steven S. Paik	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-31 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-31, 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/31/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 23, 2003 has been entered.

Response to Amendment

2. Receipt is acknowledged of the Amendment filed December 23, 2003. The amendment includes cancellation of claims 1-7 and 32 and addition of new claims 35-40.

Claim Objections

3. Claim 12 is objected to because of the following informalities: the recited element "first portion" lacks a proper antecedent basis. The examiner respectfully requests amending the recited element as either -- said portion -- or -- the portion --. Appropriate correction is required.

4. Claims 21-23 are objected to because of the following informalities: the phrase, "the aperture" in line 4 lacks a proper antecedent basis. The examiner respectfully requests replacing the phrase with -- an aperture --. Claims 22 and 23 are objected due to their dependency. Appropriate correction is required.

5. Claim 34 is objected to because of the following informalities: The applicant indicated that claim 34 is not entered and added the identical claim as claim 40. The applicant is respectfully requested to cancel claim 34 when responding to this Office Action. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-20, 24-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al. (US 4,774,399) in view of Inazaki et al. (JP403083480A).

Re claims 8, 11, 13-18 and 24, Fujita et al. disclose a reading station (apparatus 12) for reading (col. 2, ll. 3-10) a portable storage device (IC card 10) operable to provide a predetermined processing to a system unit, the storage device (IC card 10) comprises a circuit (integrated circuit 15), a circuit interface (IC card contacts; col. 6, ll. 1-5) and an opening (notch 16) at an edge of the device, the reading station comprises a device (IC card 10) receiver (IC card insertion hole 18) configured to receive the device (IC card 10) and a device reader (circuit accommodated in housing 17; circuit board 26) operable to interface (via connector 28) with the circuit interface (14) when the device (IC card 10) is received by the device receiver (IC card insertion hole 18), the device receiver further being configured to enable a restraint (engagement portion 30 operated by operating portion 20 which is one piece of element having different sides and portions) to engage the opening (notch 16 or hole 40) in the device to retain the device (IC card 10) at the reading station (col. 3, ll. 26-59; col. 5, ll. 56-64), the restraint being located at the exterior (the engagement portion is located at the exterior of the housing 17) of the reading station (12). Fujita et al. further disclose different shapes of the restraint performing the same

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function of engaging the portable storage device at a secured reading position. As disclosed by Fujita et al. the shapes and method of securing the portable storage device may be selected based on the how the storage device is inserted via an insertion hole.

Although it is well known that an IC card has many different industrial applications, Fujita et al. do not specifically disclose the predetermined function is a system configuration.

Inazaki et al. disclose an IC card storing system configuration information to help its user organize the layout of a system. As mentioned above, an IC card has many other applications besides the system configuration information such as credit card information, electronic purse information, personal identification, a patient information, and toll access information and the like.

In view of Inazaki et al., it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further incorporate an IC card that stores a system configuration information in addition to the IC card reading apparatus (12) and the IC card (10) of Fujita et al. due to the fact that any IC card with a predetermined processing information can be used in the reading/processing apparatus for the purposes of completing a predetermined function of an IC card. Furthermore, such modification of employing an IC card with system configuration information to the teachings of Fujita et al. would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Re claims 9, 19 and 20, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 8 and 18 stated above, wherein the device receiver (IC card insertion hole 18) comprises a formation defining a passage (col. 5, ll. 56-64) configured to receive the portable storage device (IC card 10; col. 3, ll. 26-36 and col. 5, ll. 56-64). The front side where

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an IC card (10) is inserted is interpreted as a wall having an insertion slot (with a protuberance (cover 22) having a longitudinal and a latitudinal cross-sectional area).

Re claims 10 and 12, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 9 and 11 stated above, wherein the passage is slot-shaped (IC card insertion hole 18) so as to receive a portable storage device (IC card 10) in the form of a system configuration device (col. 3, ll. 26-59 and col. 5, ll. 56-64).

Method claims 25-29 are essentially the same in scope as apparatus claims 8-10 and are rejected similarly.

Re claims 30 and 31, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claims 8 and 11 stated above, wherein the portable storage device including:

- a circuit (IC 15);
- a circuit interface (14 and col. 5, ll. 31-33); and
- an opening (notch 16) at an edge of the device.

Re claim 33, Fujita et al. in view of Inazaki et al. disclose the reading station as recited in rejected claim 24 stated above, wherein the portable storage device, the portable storage device (IC chip may have many different applications as stated above) being operable to provide system configuration information to the computer system and including:

- a circuit (IC 15);
- a circuit interface (14 and col. 5, ll. 31-33); and
- an opening (notch 16) at an edge of the device.

8. Claims 21-23 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al. (US 4,774,399) in view of Bleier (US 6,382,508).

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Regarding claims 21-23 and 34-40, Fujita et al. disclose a mechanism for preventing erroneous inserting and ejecting of a memory card. The reference discloses a portion that can be operated externally to secure a memory card in a card-reading device.

However, Fujita et al. do not specifically disclose the card-reading device being mountable in a wall of another computing system.

Bleier discloses a smart card (memory card is a type of a smart card) reader that can be mounted in a wall of a system. Figure 1 discloses a first portion (3) having a larger cross-sectional area that defines a protuberance to project from the wall, a second portion (2) of a smaller cross-sectional area to be received within the aperture in the wall. The first and second portion allows the card reading device to be connected to a system unit without running cables between a card reader and a system unit such as a POS terminal or an ATM.

In view of Bleier, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ the first portion (3) having a larger cross-sectional area that defines a protuberance to project from the wall and the second portion (2) of a smaller cross-sectional area to be received within the aperture in the wall in addition to the card reading device of Fujita et al. due to the fact that unnecessary cable and wires connecting the card reading device to a system unit such as a POS terminal or an ATM. can be eliminated for the purposes of keeping the system losing connection or power from inadvertent disconnect. Furthermore, such modification of employing a card reading device inserted in a system unit to teachings of Fujita et al. would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Response to Arguments

9. Applicant's arguments with respect to claims 8-33 have been considered but are moot in view of the new ground(s) of rejection.

The applicant cancelled claim 1-7 and 32 and added new claims 35-40. The applicant also amended independent claims to recite the restraint being located at the exterior of the reading station. The restraint in the cited reference is one piece having a portion located externally and a portion located interior of the reading device. Without the control of the external portion, the internal portion is not functional. Therefore, the restraint in the reference is both externally and internally located.

The examiner carefully considered the response and the newly added limitations in the independent claims. The present claims are rejected in view of the new ground of rejection. Therefore, claims 8-31, 33-40 are rejected under 35 U.S.C. § 103(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1551.

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Steven Paik

Steven S. Paik
Examiner
Art Unit 2876

ssp
February 12, 2004